

THIS DISPOSITION  
IS NOT CITABLE AS  
PRECEDENT OF  
THE TTAB

Mailed: August 13, 2003

Paper No. 13

CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

-----  
Trademark Trial and Appeal Board  
-----

In re Paramount Pool Services, Inc.  
-----

Serial No. 76/204,725  
-----

Todd Wengrovsky of Law Offices of Todd Wengrovsky for  
Paramount Pool Services, Inc.

Angela M. Micheli, Trademark Examining Attorney, Law  
Office 108 (David Shallant, Managing Attorney).  
-----

Before Hairston, Walters and Rogers, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Paramount Pool Services, Inc. filed an application  
to register on the Principal Register the mark  
POOLANDSPA.COM for, as amended, "mail order and online  
ordering of swimming pools, spas, hot tubs, parts,

chemicals, equipment, supplies and accessories and print publications related thereto," in International Class 35.<sup>1</sup>

The Trademark Examining Attorney initially refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's proposed mark is merely descriptive when used in connection with its services. Applicant responded, on July 5, 2001, by amending its application to seek registration on the Supplemental Register. The Examining Attorney issued a refusal to register, which was ultimately made final, under Section 23 of the Trademark Act, 15 U.S.C. 1091, on the ground that the proposed mark is generic in connection with the identified services.<sup>2</sup>

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

With respect to genericness, the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith,*

---

<sup>1</sup> Serial No. 76/204,725, filed February 5, 2001, based on use of the mark in commerce, alleging first use and use in commerce as of April 26, 1997.

<sup>2</sup> While the Examining Attorney never explicitly accepted the amendment to the Supplemental Register, she based her refusal on Section 23 of the Trademark Act, which pertains to the Supplemental Register. Thus, we consider this to be an application for registration on the Supplemental Register.

*Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the category or class of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that category or class of goods or services? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

The Examining Attorney contends that the POOLANDSPA portion of applicant's mark is the generic name for the class of goods that applicant's services offer for sale, i.e., pools and spas and pool and spa equipment and supplies. She submitted numerous excerpts of articles retrieved from the LEXIS/NEXIS database showing that the phrase "pool and spa" is commonly used to refer to a field of products and services, e.g., "pool and spa

---

equipment," "pool and spa dealer," "pool and spa supplies store." The Examining Attorney contends that the second portion of applicant's mark, .COM, "is a top level Internet domain name that does not serve in a source-identifying role[;] [i]t serves to show that applicant is a commercial entity doing business on the Internet."

[Brief, pg. 3.] She concludes that the mark in its entirety, POOLANDSPA.COM, is a generic term for the class of pool and spa products that applicant sells via the Internet and by mail, and that, as evidenced by the LEXIS/NEXIS excerpts, consumers would immediately recognize it as such. The Examining Attorney refers to the copy of one of applicant's web pages, submitted by applicant, that clearly states that applicant offers pools, spas, and pool and spa equipment and supplies for sale through its web site.

Applicant concedes that its mark is merely descriptive, but argues that it is not generic and that it is capable of distinguishing applicant's services from those of others.<sup>3</sup> Applicant's principal argument is that

---

<sup>3</sup> In its brief, applicant contends, for the first time, that its alleged mark has acquired distinctiveness. This argument has been given no consideration because the refusal at issue in this appeal is on the ground of genericness, and, further, because this is an application on the Supplemental Register, where the issue is whether the subject matter is capable of being a trademark, not whether it has acquired distinctiveness.

many "similarly situated marks" have been registered. In support of this position, applicant lists in its brief eight alleged third-party registrations for various marks that end with the ".com" term.

The Examining Attorney has objected, in her brief, to the list of third-party registrations submitted by applicant on the ground that this evidence is in improper form and, furthermore, that it is inapposite because the listed marks are registered on the Supplemental Register. Applicant is seeking registration on the Supplemental Register and, thus, the mere fact that the third-party marks are registered on the Supplemental Register does not make these registrations inapposite. However, we agree that this evidence is both in improper form and untimely and, therefore, we have not considered it.<sup>4</sup> Further, even if we considered this list of third-party registrations, it would be of little probative value, as each case must be decided on its own facts.

We begin our analysis by taking judicial notice of the following definition of ".com":

---

<sup>4</sup> In order to make these registrations properly of record, soft copies of the registrations themselves, or the electronic equivalent thereof, i.e., printouts of the registrations taken from the electronic records of the Patent and Trademark Office's (PTO) own database, should have been submitted. See, *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992).

(.COMmercial) A top-level Internet domain used mostly by businesses in the U.S. and Canada. However, there are .com Web sites in almost every country in the world as well as for individuals. Many believe the .com domain is the most desirable, because it was the first commercial domain name, and all the major companies in the world have .com Web sites. *The Business Technology Network TechEncyclopedia*, October 9, 2001. [www.techweb.com/encyclopedia.]

We find that this case is analogous to the decision of the Board in *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002), wherein the Board found the proposed mark CONTAINER.COM to be generic in connection with retail sales and rental of containers. In that case, the Board stated the following:

In the case before us, contrary to *Dial-A-Mattress* [*In re Dial-A-Mattress Operating Corp.*, 24 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001)], the mark cannot be characterized as a mnemonic phrase. It is instead a compound word, a generic term combined with the top level domain indicator, ".COM." In proving genericness, the Office may satisfy its burden by showing that these separate generic words have a meaning identical to the meaning common usage would ascribe to those words as a compound. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). In a similar sense, neither the generic term nor the domain indicator has the capability of functioning as an indication of source, and combining the two does not result in a compound term that has somehow acquired this capability.

As in *In re Martin Container, Inc.*, the matter for which registration is sought herein, POOLANDSPA.COM, is incapable of identifying the source of applicant's services. The evidence clearly establishes that "pool and spa" is widely used as, essentially, a compound word to refer to a class of products that encompass the goods offered via applicant's Internet web site and by mail. As stated in *In re Martin Container, Inc., supra*, the term ".COM" is merely a top-level domain indicator (TLD), which is a necessary part of an address on the Internet. As with business entity designations such as "INC." or "CO.," it has no source indicating significance to the purchasing public, and cannot serve any service mark purpose. See *In re Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988), ["PAINT PRODUCTS CO" held incapable of identifying and distinguishing paints], and *In re E.I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984), ["OFFICE MOVERS, INC." held incapable of identifying and distinguishing office facilities moving services]. See also: 1 J. McCarthy, *McCarthy on Trademarks & Unfair Competition*, Section 7:17.1 (4th ed. 2002) at 7-28.1 {"a top level domain ('TLD') indicator (such as '.com') has no source indicating significance and cannot serve any trademark (or service mark) purpose [and] the same is true of other

non-distinctive modifiers used in domain names, such as 'http://www' and 'html'; [thus, because] the TLD '.com' functions in the world of cyberspace much like the generic indicators 'Inc.,' 'Co.,' or 'LTD.' placed after the name of a company, [a] top level domain indicator like '.com' does not turn an otherwise unregistrable designation into a distinctive, registrable trademark (or service mark)".

We find that the individual words making up the term POOLANDSPA.COM have the same meaning that common usage would ascribe to them as a compound and, thus, POOLANDSPA.COM, used in connection with the identified services is incapable of registration on the Supplemental Register. See *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

*Decision:* The refusal under Section 23 of the Act on the ground that the subject matter of this application is generic is affirmed.